IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Randall Frank et al.	Art Unit	: 2143
Serial No.	: 10/728,374	Examiner	: Anish Sikri
Filed	: December 4, 2003	Conf. No.	: 6383
Title	: INTEGRATING MULTIPLE COMMUNICATION MODES		

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Commissioner for Patents
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BRIEF ON APPEAL

(1)   Real Party in Interest

The real party in interest is FMR Corp., a corporation of Delaware having a place of Business at 82 Devonshire Street, Boston, MA 02109, as evidenced by an assignment executed September 27, 2007 and recorded at the U.S. Patent and Trademark Office June 5, 2008 at Reel 021053, Frame 0813.

(2)   Related Appeals and Interferences

There are no related appeals or interferences.

(3)   Status of Claims

Claims 34 to 88 have been canceled. Claims 1 to 33, 89 and 90 have been rejected and are on appeal. Of these, claims 1, 18, 33 and 89 are independent.

(4)   Status of Amendments

All amendments have been entered.

(5)   Summary of Claimed Subject Matter

All citations herein are made with reference to the specification of this application, filed on December 4, 2003.

Claim 1

Claim 1's limitation of "receiving from a first person a request to converse with a second person using a selected first one of two or more selectable communication modes" is taught on page 14, lines 18 to 28.

Claim 1's limitation of "in response to the received request, automatically performing an action using a second one of the two more communication modes, selection of the second mode being determined by a rule created by the second person" is taught on page 10, lines 7 to 9; page 11, line 24 to page 12, line 3; page 12, lines 24 to 25; page 17, lines 14 to 31; and figure 6.

Claim 12

Claim 12's limitation of "forwarding the request to converse to a third person if a current status of the second person is that the second person is unavailable to converse and the third person is available to converse" is taught on page 17, lines 14 to 31.

Claim 18

Claim 18's limitation of a "computing device" is taught on page 10, lines 3 to 5; page 12, lines 4 to 11; page 19, lines 10 to 20; and figures 1, 2 and 8.

Claim 18's limitation of "a transceiver configured to receive a request to converse with a user of the computing device using a selected first one of two or more selectable communication modes" is taught on page 14, lines 18 to 28; page 19, lines 7 to 20; and figures 1, 2 and 8.

Claim 18's limitation of an "integration module" is taught on page 10, lines 7 to 9; page 11, line 12; page 12, lines 24 to 30; page 18, lines 1 to 2; and figure 2.

Claim 18's limitation of "automatically perform[ing] an action using a second one of the two or more communication modes, selection of the second mode being determined by a rule created by the user based on the received request" is taught on page 10, lines 7 to 9; page 11, line 24 to page 12, line 3; page 12, lines 24 to 25; page 17, lines 14 to 31; and figure 6.

Claim 24

Claim 24's limitation that "a telephone [is] configured to send the request to converse" is taught on page 9, lines 21 to 26; page 18, line 26 to page 19, line 6; and figure 1.

Claim 29

Claim 29's limitation that "the switched local area network is configured to connect to an internet protocol/public switched telephone network gateway" is taught on page 18, line 26 to page 19, line 6; and figure 8.

Claim 33

Claim 33's limitation of "receiv[ing], from a first person, a request to converse with a second person using a selected first one of two or more selectable communication modes" is taught on page 14, lines 18 to 28; page 19, lines 7 to 20; and figure 8.

Claim 33's limitation of "in response to the request, automatically perform[ing] an action using a second one of the two or more communication modes, selection of the second mode being determined by a rule created by the first user" is taught on page 10, lines 7 to 9; page 11, line 24 to page 12, line 3; page 12, lines 24 to 25; page 17, lines 14 to 31; and figure 6.

Claim 89

Claim 89's limitation of "a computer device" is taught on page 10, lines 3 to 5; page 12, lines 4 to 11; page 19, lines 10 to 20; and figures 1, 2 and 8.

Claim 89's limitation of "a user interface that is configured to enable a user to interact with a person using one mode of at least two of voice conversation, voice-video conversation, graphic text-based conversation, fax, and electronic mail" is taught on page 9, lines 19 to 24, page 13, lines 1 to 8; page 14, lines 18 to 25; and figure 3.

Claim 89's limitation of "creating a rule to cause the computer device to automatically perform an action using a first one of the at least two modes, selection of the first mode being

based on a request to converse with the user using a selected second communication mode" is taught on page 10, lines 7 to 9; page 11, line 24 to page 12, line 3; page 12, lines 24 to 25; page 17, lines 14 to 31; and figure 6.

Claim 89's limitation of "viewing an automatically generated listing of a set of persons, the listing comprising a name, presence information, and communication modes available for the user to communicate with the person from the set of persons" is taught on page 13, lines 9 to 25; page 14, lines 10-17; page 14, lines 18 to 23; and figure 3.

Claim 89's limitation of "selecting the person from the set of persons" is taught on page 13, lines 26 to 30.

Claim 89's limitation of "selecting a communication mode from the communication modes available to communicate with the person" is taught on page 14, lines 18 to 25.

Claim 89's limitation of "retrieving information about a person using an identifying characteristic of the person, where the identifying characteristic is selected by the user from a display" is taught on page 13, line 26 to page 14, line 5.

Claim 89's limitation of "communicating with the person" is taught on page 14, line 26 to page 15, line 1 and at figure 3A.

(6)   Grounds of Rejection to be Reviewed on Appeal

1. Claims 1-9, 11, 13-23, 25-28, 33, 89 and 90 stand rejected as being rendered obvious by *Tang* (U.S. Patent 5,793,365) in combination with *Loveland* (U.S. Patent 6,895,558) under section 103(*a*).

2. Claims 10, 24 and 29-32 stand rejected as being rendered obvious by the combination of *Tang, Loveland* and *Rudy* (U.S. Patent 6,360,252) under section 103(*a*).

3. Claim 12 stands rejected as being rendered obvious by the combination of *Tang, Loveland* and *Malik* (U.S. Patent Publication 2004/0078443) under section 103(*a*).

(7)   Argument

Appellants' specification

Appellant discloses integration software that automatically handles received communication requests. Using integration software, users communicate with one another using multiple modes of communication, such as voice messages, instant messages and e-mail.

The integration software includes a graphical user interface through which a user may program a rule for handling incoming communications from another user. To define a rule, the user defines actions to execute upon the occurrence of certain defined conditions. For example, some rules include conditions that are based on a user's status such as "In a Meeting," "On Vacation," "Sick" or "At work but Not on Computer." In addition to a given status, the user can also specify other conditions, such as a range of dates and times during which the rule applies.

The user then defines an action to perform when a communication is received from another user. For example, the user may specify that an incoming telephone call from another user should be routed to voicemail, or forwarded to the user's current location. In either case, it is the user who controls how another user contacts him.

Tang

Tang discloses a "gallery window 10" that allows users to communicate with each other. For each user, the "gallery window 10" displays that user's "level of activity." Like Appellants' system, *Tang*'s levels of activity include different classes of activity, such as "attentive," "idle," "engaged," "do not disturb," or "absent."[1] These activity levels provide a user with "social cues" about the "appropriateness" of contacting another user.

However, *Tang* never discusses a user-defined rule for handling incoming communications based in part on an activity level. In *Tang*, the user has no real control over incoming communications. At best, a user can place a "do not disturb" sign in his gallery window profile (see **17d** in *Tang* FIG. 1A), and hope that peers will respect his wishes.

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[1] *Tang,* column 5, line 56 to column 6, line 7.

In fact, *Tang* discloses the converse of what is claimed. According to *Tang*, it is the user sending the communication, not the user receiving the communication, who chooses the mode of communication. In particular, *Tang* states that:

> "The gallery window 10 provides access to various communication services through a contact button 16. In a preferred embodiment, the current worker may engage any available communication mechanism with one or more of the workers represented in the gallery window 10 through simple point and click operations. In one embodiment, the current worker selects one or more of the icons 14, 17 in the gallery window 10, and then presses the contact button 16."[2]

Tang repeatedly points out that it the user sending the communication who directs the form of communication. For example, in a later passage, *Tang* describes:

> "from the gallery window 10 the stick-up button 18 allows the current worker to create a message that may include text, recorded audio or video or the like, and direct that message to one or more workers selected from the displayed icons."[3]

Therefore, *Tang* fails to teach a system in which it is the user *receiving* the communication who selects the mode of communication, let alone doing so by a rule. *Loveland* fails to remedy this deficiency, resulting in a flawed 103 rejection. These flaws are discussed in more detail below.

Loveland

Loveland discloses a personal interactive media response ("IMR") system that receives communications and routes the communications to an appropriate destination. In this regard, *Loveland* describes:

> "The personal IMR application 202 receives communications, including phone calls and electronic messages (e.g., email), in a variety of formats and routes the communications to a variety of destinations according to a set of rules defined for the particular recipient of the communications."[4]

Loveland's "set of rules" does not include "a rule created by the second person" that determines "selection" of the "second" mode of communication. Instead, in *Loveland*, the mode

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[2] *Tang*, column 7, line 65 to column 8, line 5.
[3] *Tang*, column 8, lines 52 to 57.
[4] *Loveland*, col. 12, lines 40-45.

of communication is selected by the IMR system. However, an IMR system is not a "second person." Specifically, *Loveland*'s IMR system selects the communication mode based on the "best method available:"

> "*A rules engine attempts to establish communication between the two users via the **best method available**. For example Person A calls Person B. Person B has set the find me status to out of the office. Person B's out-of-the-office device is a two-way pager capable of receiving pages, e-mail, and instant messages. The IMR system attempts to determine the capabilities of Person A's terminal either through querying the device directly or asking the user interactively through an interactive voice response menu."*[5]

Because *Loveland* fails to teach that selection of the communication mode is determined by a rule "created by the second person," *Loveland* fails to teach the claimed limitation of "in response to the received request, automatically performing an action using a second one of the two or more communication modes, selection of the second mode being determined by a rule created by the second person." As a result, *Loveland* in combination with *Tang* fails to render claims 1, 18, 33 and 89 obvious. Moreover, even assuming that *Loveland* did teach these limitations, which it doesn't, the Examiner has failed to provide a convincing line of reasoning as to why it would have been obvious to one of ordinary skill in the art to combine *Loveland* with *Tang*.

Rudy

Rudy discloses a method of presenting email attachments on a device that renders "it for presentation to the user," thus "avoiding attachment presentation problems."[6] As discussed in more detail below, for claims 24 and 29, *Rudy* fails to teach the claimed limitations. Moreover, for claims 10, 24 and 29-32, the Examiner has failed to provide a convincing line of reasoning as to why it would have been obvious to one of ordinary skill to combine *Rudy* with *Tang* and *Loveland*. These deficiencies result in flawed 103 rejections for claims 10, 24 and 29-32.

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[5] *Loveland* at column 12, lines 45 to 53.
[6] *Rudy*, column 1, lines 64 to 65.

Malik

    Malik discloses a method for transferring instant messages from one user to another user. *Malik* describes "message reply logic" that sends an auto-reply message "in response to receiving an IM message from the sender."[7] *Malik* also describes "message transfer logic" that forwards a message to the user at a different IM address.[8]

    Malik does not, however, discuss sending reply or forwarded messages based on a party's availability. This deficiency results in a flawed 103 rejection for claim 12. This flaw is discussed in more detail below.

Section 103 rejection of claim 1

As discussed in detail below, the section 103 rejection is improper for at least the following reasons:

1. *Loveland* fails to teach selection of a communication mode determined by a rule created by a "second person;"

2. *Loveland* fails to teach "in response to the received request, automatically performing an action using a second one . . . of the communication modes;" and

3. The Examiner provides a conclusory assertion as to why one of ordinary skill in the art would have been motivated to combine *Loveland* with *Tang*.

***Loveland* fails to teach a selection of a communication mode determined by a rule created by a person**

    Claim 1 requires that "*selection of the second mode [of communication]*" be "*determined by a rule created by the second person*." The Examiner identifies *Loveland*'s teaching of "best method available" communication routing as allegedly teaching this step. As previously addressed in Section (7) (See discussion of *Loveland*), the "best method available" is determined by the IMR system's *rules engine* and is not determined by a rule created by "*the second person*" (i.e., the person with whom the first person would like to communicate).

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[7] *Malik*, paragraph 75.
[8] *Id.*

In fact, according to *Loveland*, it is the IMR system's rules engine that "formulates a response" to a received communication, with part of that response formulation including selection of a communication mode by the rules engine. Therefore, instead of teaching claim 1's limitation that "selection of the second mode [of communication]" is "determined by a rule created by the second person," *Loveland* teaches that the IMR system's rules engine, not a person, determines how to establish communication between two people.[9] The rules engine does so by accessing various parameters, some of which are user-defined and some of which are automatically defined by the IMR system. However, *Loveland*'s mere accessing of user-defined parameters does not result in "a rule created by the second person," because *Loveland*'s IMR system, and not "the second person," is determining the mode of communication that is established between a first and second person.

For example, the rules engine employs various "user-defined options" in formulating the response. However, these user-defined options only specify the "type of response" (e.g., leaving a message) or a user's state (e.g., "on the phone" or "in a meeting") and thus fail to produce "a rule created by a [] person."

For example, regarding the "type of response," *Loveland* teaches

> "*A portion of the parameters potentially accessed by the rules engine component 330 are designated via user configuration interfaces. A set of user defined options 340 specify a user customizable set of <u>response options</u> that are applied by the rules engine component 330 to formulate a call response.*"[10]

A subsequent passage from *Loveland* clarifies that "response options" actually refer to a *type* of response, independent of the mode used in communicating the response:

> "*The <u>response</u> may request the caller to leave a message—which could be placed in a voice mailbox, email box or an instant message for the recipient.*"[11]

Notably, the "response" is characterized by the response *type*. In the above passage, the response type of "leaving a message" actually includes three different communications modes: telephone, email or instant message. The response type does not specify a communication mode

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[9] *Loveland,* column 12, lines 43 to 44.
[10] *Loveland,* column 17, lines 6 to 11.
[11] *Id.* at column 17, line 67 to column 18, lines 1 to 2.

and therefore *Loveland*'s "type of response" is not a "selection of the second mode [of communication]" that is "determined by a rule created by the second person."

Loveland's other "user defined option" is a "user state," which represents the user's availability:

> *"A user state 342 specifies the status of a call recipient. For example the recipient may be in/out of the office, on the phone, in a meeting, etc."*[12]

Similar to *Loveland*'s "response options," the "user state" fails to produce "a rule created by the second person" to "select [a] mode [of communication]." In fact, the "user state" fails to select any mode of communication at all. Moreover, the "user state" is only one of many parameters applied by the rules engine in formulating a response, none of which are "user-defined" parameters. For example, automatically set values, such as a "terminal state," "present status" and "data values" are used by the IMR system in determining the communication mode:

> *"The rules engine component 330 consults automatically set values to formulate a response. For example a **terminal state** 348 may be accessed. The terminal state 348 may include whether a computer terminal is on, being used, is on standby/screen saver mode. The terminal state 348 may include whether the phone is off-hook or the do not disturb feature has been activated in order to formulate a response."*[13]

As described, the terminal state is used by the IMR system to determine the "best method available." For example, if a user's phone is "off-hook" then the "best method available" would not include the phone, but perhaps it would include e-mail or a page. The IMR system's rules engine then combines the "user-defined options" with the "terminal state" and other parameter values, such as "present status" and "data values," in "formulating a response:"

> *"If a set of rules have been established for the identified caller and the identified mode of access, then control passes to step 410 wherein the rules engine component 330 processes the call in accordance with a configured response options (specified for both the caller and the recipient) **and** the **present status** and **data values** for the call recipient."*[14]

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[12] *Id.* at column 17, lines 11 to 13.
[13] *Loveland*, column 17, lines 22 to 28.
[14] *Id.* at column 17, lines 53 to 59.

Simply put, the "user-defined options," "terminal state," "present status" and "data values" for the call recipient are used by the *IMR system,* not a person, to determine the "best method available" communication mode. For these reasons, *Loveland* fails to teach that "selection of the second mode [of communication]" is "determined by a rule created by the second person."

Loveland fails to teach "in response to the received request, automatically performing an action using a second one . . . of the communication modes."

Claim 1 also includes the limitation of

in response to the received request, automatically performing an action using a second one of the two or more communication modes

For this limitation, the Examiner cites the following passage from *Loveland*:

"*For example if Person A's terminal (a phone) is a phone capable of sending instant messages, the IMR will establish an instant messaging (IM) session between the two users. If Person A's terminal is not capable of sending e-mail or an instant message, the IMR will allow Person A to send a numeric page to Person B.*"[15]

By citing this passage, the Examiner ignores the limitation that the automatically performed action uses a mode of communication that is selected by a "second *person.*" By describing that the IMR establishes an IM session or that the IMR "allows" a person to send a numeric page, *Loveland* teaches that the IMR, not a person, selects the mode of communication. For this additional reason, *Loveland* fails to teach the claimed limitations.

The Examiner provides a conclusory assertion that one of ordinary skill in the art would have been motivated to combine *Loveland* with *Tang*

In finding that *Tang* in combination with *Loveland* renders claim 1 obvious, the Examiner reasoned that:

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[15] *Id.* at column 12, lines 54 to 59.

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> *"Both Tang-Loveland provide features related to communication in the network*
> *with the use of rule management. Therefore one of ordinary skill in the art would*
> *have been motivated to combine the teachings since both are within the same*
> *environment. Therefore, it would have been obvious to a person skilled in the art*
> *at the time of the invention was made to incorporate the use of rule management*
> *taught by Loveland, in the system of Tang for the purposes of management of*
> *different types of communication methods/preferences as stated by the user."*[16]

By explaining that it would have been obvious to combine elements taught by *Loveland*
with elements taught by *Tang*, the Examiner relies on a "combining prior art elements"
obviousness argument.[17] However, as articulated in the MPEP, such a rationale requires "a
finding that the prior art included each element claimed."[18] As discussed above, *Loveland* fails
to teach "automatically performing an action using a second one of the two or more
communication modes, selection of the second mode being determined by a rule created by the
second person." Therefore, the Examiner has failed to establish a *prima facie* case of
obviousness.

Moreover, *Loveland* actually teaches away from "selection of the second
[communication] mode being determined by a rule created by the second person" by describing
that a feature of the IMR system is its "flexible" nature that can establish a communication
between users "via the best available method" which is selected by the IMR system.
Additionally, *Tang* also teaches away from "selection of the second [communication] mode
being determined by a rule created by the second person" by describing that "the selection
process [of choosing a communication mode] is *preferably* automatic and transparent to the
user."[19] Because both *Tang* and *Loveland* teach away from this limitation it is "more likely to be
nonobvious,"[20] to combine *Tang* and *Loveland* to produce a "selection of the second
[communication] mode being determined by a rule created by the second person" is "more likely
to be nonobvious."[21]

[16] October 31, 2008 Office Action, ¶¶5-6 at page 4.
[17] MPEP, §2143(A), 2100-129, *Eighth Edition, September 2007.*
[18] *Id.*
[19] *Tang*, column 8, lines 10 to 11.
[20] *KSR Intern. Co. v.Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007) ("When the prior art teaches away from combining
certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.").
[21] This statement assumes arguendo that *Tang* and *Loveland* in combination teach all the limitations of claim 1,
which they don't for the reasons explained herein.

Additionally, the Supreme Court has recognized that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."[22] Assuming *arguendo* that both *Loveland* and *Tang* in combination taught all the elements of claim 1, which they don't, the Examiner's analysis still fails to explain *why* one of ordinary skill in the art would be motivated to combine *Loveland* and *Tang*. Instead, the Examiner makes for the generalized statement that "both are within the same environment" of "rule management." The alleged fact that *Loveland* and *Tang* are in the "same environment" does not, without more, produce a motivation to combine. If this were the case, then any combination of rules based systems would be obvious because under the Examiner's reasoning all rules based system, without reference to the *type* of rules, are obvious. The Examiner has therefore also failed to provide any "articulated reasoning" in support of his obviousness rejection.

Independent claims 18, 33 and 89 include limitations similar to those above. Accordingly, the section 103 rejection of those claims is improper for at least the same reasons given above. The section 103 rejection of dependent claims 2-17, 19-32 and 90 is improper for at least the same reasons for which the rejections of the claims on which they depend is improper.

Section 103 rejections of claims 10, 12, 24, and 29-32

In addition to the reasons addressed above, the section 103 rejection of claims 10, 12, 24 and 29-32 is improper for at least the following, additional reasons:

1. The section 103 rejection of dependent claim 10 is improper for at least the same reasons for which the rejections of claim 1 and claim 7 are improper;

2. Regarding claims 10, 24 and 29-32, the Examiner has failed to articulate "with some rational underpinning" any reason to combine *Loveland*, *Tang* and *Rudy*;

3. Regarding claim 12, the Examiner has failed to articulate "with some rational underpinning" any reason to combine *Loveland*, *Tang* and *Malik*;

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[22] *KSR Intern. Co. v.Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007).

4. Regarding claim 12, *Malik* fails to teach "automatically performing the action . . . [if] the third person is available to converse"; and

5. Regarding claim 29, *Rudy* fails to teach "*the switched local area network is configured to connect to an internet protocol/public switched telephone network gateway.*"

The Examiner has failed to articulate "with some rationale underpinning" any reason to combine *Loveland, Tang* and *Rudy* or *Loveland, Tang,* and *Malik*

For claims 10, 24 and 29-32, the Examiner fails to advance a convincing line of reasoning as to why one of ordinary skill would combine the teachings of *Rudy, Loveland* and *Tang.*[23] Instead the Examiner makes the conclusory assertion that "[b]oth Tang-Loveland-Rudy provide features related to different types of communication methods in the network. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment."[24] However, this "same environment" generalization falls short of providing the "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" that the Supreme Court mandated in *KSR Intern. Co.*[25] Simply put, the Examiner fails to explain *why* one of ordinary skill in the art would be motivated to combine *Rudy, Loveland* and *Tang.* Instead, the Examiner makes the erroneous assumption that one of ordinary skill in the art would be motivated to combine *Rudy, Loveland* and *Tang* simply because these three references are generally in the "same environment." Under the Examiner's unsupported reasoning, it would be obvious to combine *any* and *all* references which generally cover technology in the "same environment," in which case all inventions in a given "environment" would be rendered obvious. Clearly, such a result is incorrect and unsupported by *KSR. Intern. Co.*[26]

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[23] *See Ex Parte Clapp*, 227 U.S.P.Q.2d 972, 973 (Board. Pat. App. & Inf. 1985).
[24] October 31, 2008 Office Action, §68 at page 19.
[25] *KSR Intern. Co. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).
[26] *KSR Intern. Co. v.Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007) ("Rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")

For claim 12, the Examiner offers the same conclusory assertion as to why one of

ordinary skill in the art would be motivated to combine *Malik, Loveland* and *Tang*.[27] Because

the Examiner again fails to explain the "rational underpinning" of his conclusion, the Examiner's

rejection of claim 12 is similarly flawed.

**Section 103 rejection of claim 12: *Malik* fails to teach "automatically performing the action
. . . [if] the third person is available to converse"**

Claim 12 recites the additional limitation of:

> *automatically performing the action further comprises forwarding the request to
> converse to a third person if a current status of the second person is that the
> second person is unavailable to converse and the third person is available to
> converse*

The Examiner suggests that *Malik* teaches this claim limitation in the following passages:

> *The message reply logic 340 is configured to generate and convey an auto-reply
> message in response to receiving an IM message from a sender. The message
> transfer logic 345 is configured to generate and convey all IM messages that may
> be used in the event that an incoming IM message is transferred to a transferee.
> The message forward logic 350 is configured to determine the presence of the
> recipient at all of the recipient's IM addresses, and, also, to determine the last
> active time for each of those IM addresses. Additionally, the message forward
> logic 350 is configured to generate and convey all IM messages that may be used
> in the event that an incoming IM message is forwarded to another of the
> recipient's IM addresses.*[28]

> *The indicator messages 360 include all messages that are used in generating the
> XML streams. Thus, for example, the indicator messages 360 may include an
> auto-reply message that reads, for example, "Romeo is currently unavailable to
> reply to your IM message." For auto-forward, the indicator messages 360 may
> read "Romeo has most recently been active at romeo@verona.it" or "Your
> message is being forwarded to Romeo at romeo@verona.it." For auto-
> transferring, the indicator messages may read "Your message is being forwarded
> to Mercutio." While not explicitly provided, it should be appreciated that any
> message to be included in the auto-message-handling process may be stored as*

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[27] October 31, 2008 Office Action, §68 at page 19 ("Both Tang-Loveland-Malik provide features related to communication methods in network relating to users. Therefore one of ordinary skill in the art would have been motivated to combine the teaching since both are within the same environment.")
[28] *Malik*, paragraph 75.

> *one of the indicator messages 360.*[29]

However, *Malik* fails to teach the limitations of claim 12, because claim 12's performance of the action is contingent on two conditions: (a) *a current status of the second person is that the second person is unavailable to converse* and (b) *the third person is available to converse.* *Malik*'s messages are "auto-forwarded" and "auto-transferred," without any checking whatsoever as to the availability of "Romeo" or "Mercutio." Therefore, *Malik* fails to teach claim 12's limitations of checking the status of the second person and the third person. As a result, *Malik* does not disclose the subject matter missing from *Tang*'s disclosure. Accordingly, the combination of *Malik*, *Loveland* and *Tang* does not invalidate Appellant's claim 12 under section 103 and the Examiner's section 103 rejection is consequently erroneous.

Section 103 rejection of claim 29: *Rudy* fails to teach a "switched local area network" that is "configured to connect to an internet protocol/public switched telephone network gateway"

Claim 29 includes the limitation of
> *"the switched local area network" being "configured to connect to an internet protocol/public switched telephone network gateway."*

The Examiner regards this claim limitation as taught by the following passage from *Rudy*:

For example, client machines could include remote or mobile devices such as cellular telephones, pagers, landline display screen telephones, set-top boxes, general purpose computers, and so forth.[30]

However, this passage teaches neither a *"switched local area network"* nor an *"internet protocol/public switched telephone network gateway."* In fact, Appellants are puzzled by the Examiner's equation of *"cellular telephones"* and *"pagers"*[31] with a *"switched local area network,"* because neither a telephone nor a pager perform the standard functions (e.g., packet routing and packet transport) of a "switched local area network" or an "internet protocol/public switched telephone network gateway." Accordingly, because *Rudy* fails to teach the additional

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[29] *Malik*, paragraph 76.
[30] *Rudy*, column 26, lines 20 to 24.
[31] *Rudy*, column 26, lines 20 to 24.

limitation of claim 29, the combination of *Rudy, Loveland* and *Tang* fails to teach each limitation of claim 29. As a result, the Examiner's section 103 rejection of claim 29 was improper.[32]

The section 103 rejection of dependent claims 30-32 is improper for at least the same reasons for which the rejection of claim 29 is improper.

(8)   Conclusion

Because Appellants hereby reinstates Appellants' prior Appeal (see Applicant's March 17, 2008 Notice of Appeal), it is understood that all previously paid appeal fees set forth in 37 CFR 41.20 will be applied to this new appeal, in accordance with MPEP §1204.01. Please apply any additional charges or credits to Deposit Account No. 06-1050, referencing attorney docket no. 08575-0088001.

                                        Respectfully submitted,

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[32] *Velander v. Garner*, 348 F.3d 1359, 1363 (Fed. Cir. 2003) (stating that an obviousness analysis is only proper if "all the elements of an invention are found in a combination of prior art references").

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Appendix of Claims

1.   A method comprising:

receiving from a first person a request to converse with a second person using a selected first one of two or more selectable communication modes; and

in response to the received request, automatically performing an action using a second one of the two or more communication modes, selection of the second mode being determined by a rule created by the second person.

2.   The method of claim 1 wherein the rule is created by the second person using a user interface on a computing device.

3.   The method of claim 1 further comprising selecting the rule from a set of one or more rules based on a condition statement of the rule.

4.   The method of claim 1 further comprising selecting the rule based on the one of two or more communication modes.

5.   The method of claim 1 further comprising selecting the rule based on an identity of the first person.

6.   The method of claim 1 further comprising selecting the rule based on a current status of the second person.

7.   The method of claim 1 further comprising determining an electronic document associated with the first person and retrieving the electronic document if the second person indicates a desire to view the document.

8.   The method of claim 7 further comprising displaying the electronic document to the second person.

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9. The method of claim 7 further comprising retrieving the electronic document from an e-mail storage module, wherein the electronic document is an e-mail message.

10. The method of claim 7 further comprising retrieving a calendar of the second person from a calendar storage module, wherein the electronic document is the calendar.

11. The method of claim 1 wherein automatically performing the action further comprises enabling the first person to leave a message if the current status of the second person is that the second person is unavailable to converse.

12. The method of claim 1 wherein automatically performing the action further comprises forwarding the request to converse to a third person if a current status of the second person is that the second person is unavailable to converse and the third person is available to converse.

13. The method of claim 1 wherein the one of two or more communication modes comprises a voice conversation communication mode.

14. The method of claim 13 wherein the voice conversation communication mode comprises Voice over Internet Protocol (VoIP).

15. The method of claim 1 wherein the one of two or more communication modes comprises a voice/video conversation communication mode.

16. The method of claim 1 wherein the one of two or more communication modes comprises a graphic text-based conversation communications mode.

17. The method of claim 16 wherein the graphic text-based conversation communication mode comprises Instant Messaging.

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18.   A system comprising:

a computing device comprising:

a transceiver configured to receive a request to converse with a user of the computing device using a selected first one of two or more selectable communication modes; and

an integration module configured

to automatically perform an action using a second one of the two or more communication modes, selection of the second mode being determined by a rule created by the user based on the received request.

19.   The system of claim 18 wherein the integration module comprises a microphone and a speaker.

20.   The system of claim 18 wherein the integration module comprises a user interface hook to detect when the user is interacting with the computing device.

21.   The system of claim 18 wherein the integration module comprises a user interface that enables the user to specify the action.

22.   The system of claim 18 further comprising a network.

23.   The system of claim 22 further comprising a second computing device configured to send the request to converse.

24.   The system of claim 22 further comprising a telephone configured to send the request to converse.

25.   The system of claim 22 wherein the network comprises a switched local area network.

26.   The system of claim 25 wherein the transceiver is further configured to receive a request to converse via the switched local area network.

27.   The system of claim 25 wherein the switched local area network is configured to connect the computing device to an internet.

28.   The system of claim 25 wherein the switched local area network is configured to connect the computing device to an intranet.

29.   The system of claim 25 wherein the switched local area network is configured to connect to an internet protocol/public switched telephone network gateway.

30.   The system of claim 29 wherein the network further comprises a second switched local area network.

31.   The system of claim 30 wherein the second computing device sends the request to converse via the second switched local area network.

32.   The system of claim 31 wherein the network further comprises a telephone system and a public switched telephone network configured to enable the telephone to send the request to converse to the computing device.

33.   An article comprising a machine-readable medium that stores executable instruction signals that cause a machine to:

receive, from a first person, a request to converse with a second person using a selected first one of two or more selectable communication modes; and

in response to the request, automatically perform an action using a second one of the two or more communication modes, selection of the second mode being determined by a rule created by the first user.

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89.   A system comprising:

a computer device;

a user interface that is configured to enable a user to interact with a person using one mode of at least two of voice conversation, voice-video conversation, graphic text-based conversation, fax, and electronic mail; wherein the interaction comprises:

creating a rule to cause the computer device to automatically perform an action using a first one of the at least two modes, selection of the first mode being based on a request to converse with the user using a selected second communication mode;

viewing an automatically generated listing of a set of persons, the listing comprising a name, presence information, and communication modes available for the user to communicate with the person from the set of persons;

selecting the person from the set of persons;

selecting a communication mode from the communication modes available to communicate with the person;

retrieving information about a person using an identifying characteristic of the person, where the identifying characteristic is selected by the user from a display; and

communicating with the person.

90.   The system of claim 18 in which the integration module is also configure to interact with the two or more communication modes, the modes including at least two of voice conversation software, voice-video conversation software, graphic text-based conversation software, fax software, and electronic mail software.

Evidence Appendix

NONE

Related Proceedings Appendix

NONE